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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,324	09/16/2003	Tetsuya Kanekon	030192A	9165
38834 7590 03/05/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
LOFTUS, ANNE				
ART UNIT		PAPER NUMBER		
3692				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/662,324

Applicant(s)

KANEKON, TETSUYA

Examiner

ANN LOFTUS

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. This action is in response to an amendment filed on 12/14/07. Claims 1-3, 6-17 are pending. Claims 4 and 5 are cancelled.

Priority

2. This application was filed 9/16/03. Its oath claims foreign priority from Japanese Patent 2002-275073 dated 9/20/02. A certified copy is present in the record, but there is no translation as of 2/25/08.

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a certified English translation of the foreign application must be submitted in reply to this action. 37 CFR 41.154(b) and 41.202(e). Failure to provide a certified translation may result in no benefit being accorded for the non-English application.

Response to Arguments

3. Applicant's arguments filed 12/14/07 have been fully considered but they are not persuasive.
4. The applicant argues that Silberberg does not teach a server. The examiner respectfully disagrees. On page 8 lines 15-20 of the PCT version (page 3 paragraph 48 of the US version 2003 0010821) Silberberg teaches a computer at the central facility.

This computer communicates with mobile devices and performs billing functions and thus is a server. By receiving telephone calls and making deductions from accounts, it shows that it has a communications process unit performing a communicating process with a user device and a system of billing a user for up to a predetermined total time through a network.

5. As to claim 6, the applicant argues that Admasu does not teach transmitting an identification number of a system of billing a user by a predetermined time and user information from a user device. The examiner respectfully disagrees. Admasu teaches in paragraph 42 page 4 (right hand column) "the cell phone transmits the unique identification number via cellular network to the web server... calculates charges based on the elapsed time." The number is part of a system that bills a user by a predetermined time and user information from a user device. See also paragraph 27 page 2 and 3.

6. As to the rejection under 35 USC 112, second, concerning the phrase billing "by a predetermined time," applicant has improved the wording in some instances of the phrase but not addressed the others. The claims do not make explicit how the predetermined time applies to the billing system.

The examiner respectfully suggests that language such as "billing a user for an amount, the amount based on ..." would make it clear that the predetermined time is related to the amount calculations, not to the billing action, if that is the intent. If the

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predetermined time refers to a charge per time period, then that ought to be clarified. A parking meter often charges a predetermined amount per time period such as a quarter for twenty minutes. Billing by a predetermined time sounds more like the bills must be sent by 5:00 pm, or by the 25th of the month. It could mean the charges depend on the time of day, such as 10\$ until 5:00, but 2\$ after 5:00. The relationship of the predetermined time to the billing system is unclear, thus the metes and bounds of the claims are unclear.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 2, 6-8, 10-12, and 17. are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase billing "by a predetermined time" is unclear, as explained under response to arguments. While amended in some claims, it remains in claims 1, 2, 6-8, 10-12, and 17. The relationship of the predetermined time to the billing system is unclear, thus the metes and bounds of the claims are unclear.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-5, and 8-17 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 200163563 A1 (published 8/30/2001), to Silberberg.

As to claims 1, 8, 12, and 17, Silberberg teaches in paragraph 23 page 2 a communications process unit performing a communicating process and a system of billing a user by a predetermined time through a network; Silberberg teaches a user device in communication with the system in paragraph 10 page 1. Silberberg teaches billing a user by a predetermined time in paragraph 23 page 2. Silberberg teaches in paragraphs 33-41 on page 2 performing a payment by communicating with the system of billing a user by a predetermined time and obtaining charge information from the system through the network. A payment process unit is inherent if the function is present.

As to claims 2, 9, and 13, in paragraph 26 page 2 and paragraph 52 page 3, Silberberg teaches obtaining current use information from the system of billing a user by a predetermined time according to recorded information transmitted in advance from the user device or at a request from the user device, and transmitting the obtained use information to the user device.

As to claim 3, In paragraph 23 page 2 Silberberg teaches payment is made in a front-end payment system for a predetermined time. In paragraph 26 page 2 and paragraph 52 page 3, Silberberg teaches a message is transmitted to the user device at any time before the predetermined time elapses.

As to claims 4, 5, 10 and 11, in the abstract Silberberg teaches a system of billing a user by a predetermined time is a parking meter, and the charge is a parking charge for use of the parking meter.

As to claims 14, 15, and 16, Silberberg teaches in paragraph 23 and 47 page 2, a communications process unit performing a communicating process with a user device through a network. Silberberg teaches in paragraph 52 page 3 an information providing unit obtaining use information about a user who uses a system of billing a user by a predetermined time, determining a transmission timing of a message according to the obtained use information and transmitting the message to the user device through the network with the transmission timing, and (paragraphs 33-41 on page 2) a payment unit for making a payment at a payment request from the user device.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silberberg, and further in view of US Patent Application 20020032601 filed 25 Apr 01 by Admasu.

As to claim 6, obtaining an address of a system is inherent in communication with the system. Note that systems use network addresses as opposed to physical

addresses. Silberberg in paragraph 21 pages 1 and 2, teaches obtaining use information from the system at the address. Silberberg teaches in paragraphs 33-41 on page 2 adjusting a charge or providing information. Silberberg does not specifically teach transmitting an identification number of a system of billing a user by a predetermined time and user information from a user device. Admasu teaches in paragraph 42 page 4 transmitting an identification number of a system of billing a user by a predetermined time and user information from a user device. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Silberberg to transmit an identification number of a system of billing a user by a predetermined time and user information from a user device in order to uniquely identify the parking spot.

As to claim 7, in the abstract Silberberg teaches a system of billing a user by a predetermined time is a parking meter, and the charge is a parking charge for use of the parking meter.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. While portions of interest have been indicated, all references should be considered for the entirety of their teachings.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL

/Kambiz Abdi/
Supervisory Patent Examiner, Art
Unit 3692